2176 SC #19 10/21/03

ATTORNEY DOCKET NO. M. WILLIAMS 2 PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Marvin L. Williams
Serial No.:	09/234,351
Filed:	January 20, 1999
Title:	SYSTEM AND METHOD FOR ESTABLISHING RELATIONSHIPS BETWEEN HYPERTEXT REFERENCES AND ELECTRONIC MAIL PROGRAM INCORPORATING THE SAME
Grp./A.U.:	2176
Examiner:	Nguyen, M.

Commissioner for Patents
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Sir:

REQUEST FOR RECONSIDERATION UNDER 37 C.F.R. § 1.111

In response to the Examiner's Action mailed July 2, 2003, the Applicant has carefully considered this application in connection with the Examiner's Action and respectfully requests reconsideration of this application in view of the following remarks.

The Applicant originally submitted Claims 1-27 in the application. The Applicant previously amended Claims 1-2, 5, 10, 11, 14, 19-20 and 23 and has not canceled or added any claims. Accordingly, Claims 1-27 are currently pending in the application.

I. Rejection of Claims 1-27 under 35 U.S.C. §103

The Examiner has rejected Claims 1-27 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,029,164 to Birrell, *et al.* ("Birrell") in view of U.S. Patent No. 5,790,793 to Higley. As the Examiner is no doubt aware, determination of obviousness requires consideration of the invention considered as a whole; the inquiry is not whether each element exists in the prior art, but whether the prior art made obvious the invention as a whole. Furthermore, there must be some suggestion or teaching in the art that would motivate one of ordinary skill in the art to arrive at the claimed invention; a reference that teaches away from a claimed invention strongly indicates nonobviousness.

Moreover, to establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicant's disclosure.

Birrell discloses a method and apparatus for organizing and accessing electronic mail messages. Birrell describes the receipt of data records in an index server, where the data records are parsed into words, and stored in a full-text index. Labels are added to the data records and the full-text index so that the data records can be accessed by searching using queries that include the words and labels of the data records. (Abstract).

Birrell does not teach or suggest an e-mail program or a system of establishing relationships between hypertext references contained in e-mail messages where a message parser is used to locate hypertext references. The Examiner cites col. 11, lines 54-63, of Birrell as establishing relationships between hypertext references because "a displayed message contains ... 'hot links'." A careful reading of Birrell reveals that the "hot links" described therein are not referrals to a hypertext reference contained in an e-mail message. Instead, the described hot link in col. 11, lines 54-63, refers to a link created by the system described in Birrell to identify a stored e-mail message found as the result of a user query. The user can then click on this newly created hot link to recover the stored e-mail message represented thereby. That is, the hot link is created by the Birrell system for identifying a specific e-mail message found as a result of a query to enable a user to go to that message. The term "hot link" is not a reference to a hypertext reference located in an e-mail message. A similar referral to a hot link is found in col. 12, lines 8-13, of Birrell. Thus, Birrell does not teach or suggest a method or program that includes locating hypertext references in first and second e-mail messages received by an e-mail program and building hypertext messages containing the hypertext references and associations of each of the hypertext references with a sender of the first and second e-mail messages as recited in independent Claims 1, 10 and 19.

Higley does not overcome the shortcomings of Birrell. Higley describes a method and system for sending and receiving Uniform Resource Locators (URLs) in electronic mail over the Internet. If the message includes an URL, the URL is looked up when the received document is read or browsed so that the information corresponding to the URL can be displayed without necessarily displaying the received message. If the received document is a HTML type, the document can be displayed and a user can "click" on the URL to look up the information corresponding to the URL.

If the received document is a text type, the text can be converted to a HTML format and the HTML format document displayed for the user to "click" on the URL to look up the information corresponding to the URL without being required to type the URL address. (Abstract). As was the case with Birrell, Higley does not teach or suggest a method or program that includes locating hypertext references in first and second e-mail messages received by an e-mail program and building hypertext messages containing the hypertext references and associations of each of the hypertext references with a sender of the first and second e-mail messages as recited in independent Claims 1, 10 and 19.

Birrell, individually or in combination with Higley, thus fails to teach or suggest the invention recited in independent Claims 1, 10 and 19 and their respective dependent claims, when considered as a whole. Claims 1-27 are therefore not obvious in view of Birrell and Higley. In view of the foregoing remarks, the cited references do not support the Examiner's rejection of Claims 1-27 under 35 U.S.C. §103(a). The Applicant therefore respectfully requests the Examiner to withdraw the rejection.